

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/628,242
Attorney Docket No.: Q71333

REMARKS

Claims 1 to 5 are all the claims pending in the application.

In Paragraph 1, at page 2 of the Office Action, under the heading "Specification", the Examiner objects to the incorporation by reference of the Japanese priority application at page 13 of the specification, and objects to the incorporation by reference of the U.S. provisional application at page 1 of the specification. The Examiner states that these incorporations by reference are improper. The Examiner refers to 37 C.F.R. § 1.57(c) and (d) to support his assertion that these incorporations by reference are improper.

Applicants submit that 37 C.F.R. § 1.157 (c) and (d) do not prohibit the incorporations by reference that have been made in the present application.

In particular, the MPEP, at 201.13(G), states that an applicant may incorporate by reference the foreign priority application by including a statement in the U.S. application as filed that such specifically enumerated foreign priority application is "hereby incorporated by reference".

The MPEP states that the inclusion of the incorporation by reference of the foreign priority application will permit an applicant to amend the U.S. application to include any subject matter in the foreign priority application without raising the issue of new matter. The MPEP states that the incorporation by reference statement can be relied upon to permit the entering of a portion of the foreign priority application into the U.S. application when a portion of the foreign priority application has been inadvertently omitted from the U.S. application or to permit the

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correction of a translation error in the U.S. application where the foreign priority application is in a non-English language.

Thus, the MPEP specifically permits the incorporation by reference of foreign priority applications.

Similarly, with respect to the incorporation of a provisional application, the MPEP at 608.01(p) states that as a safeguard against the omission of a portion of a prior application for which priority is claimed under 35 U.S.C. § 119(a)-(d) or (f), or for which benefit is claimed under 35 U.S.C. § 119(e) or 120, an applicant may include a statement at the time of filing of the later application incorporating by reference the prior application. 35 U.S.C. § 119(e) relates to provisional applications. Thus, the MPEP specifically indicates that there can be an incorporation by reference of the provisional application as a safeguard against the omission of a portion of a prior application.

Accordingly, applicants request withdrawal of the Examiner's objections to the specification.

Claim 1 has been rejected under 35 U.S.C. § 102(b) as anticipated by EP 0 364 631 A1 to Mizumoto et al.

The Examiner states that EP '631 teaches the alloy Pt₄₆Ni₁Co₅₃ that, according to the Examiner, is encompassed by claim 1 of the present application. The Examiner refers to page 9 of EP '631 and particularly Table 1, Example 3 at page 9, where this alloy is disclosed. The Examiner states that this Example anticipates claim 1.

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In response, applicants point out that the present invention is directed to a magnetic alloy comprising Pt in an amount of 40 at% to 60 at%, and at least two 3d transition metal elements, wherein the total amount of the 3d transition metal elements is from 60 at% to 40 at%, and the average number of valence electrons in the respective 3d transition metal elements as calculated on the basis of the compositional proportions of the elements is from 7.5 to 9.

In contrast, the average number of valence electrons in the respective 3d transition metal elements of the $\text{Pt}_{46}\text{Ni}_1\text{Co}_{53}$ alloy of EP '631 would be calculated to be 9.02, which is above the 7.5 to 9 range set forth in claim 1.

Since claim 1 requires that the upper limit be 9 and the alloy the Examiner has identified has a value of 9.02, applicants submit that the $\text{Pt}_{46}\text{Ni}_1\text{Co}_{53}$ of EP '631 does not anticipate claim 1.

Further, applicants point out that technology field is different between the present invention and EP '631. As described in the "Object of the Invention" on page 3 of EP '631, the invention of EP '631 is basically related to the technology field of a magneto-optical recording media, recently often called "MO", which is totally different from that of the present invention.

The present invention relates to a magnetic alloy for a magnetic layer used in a magnetic recording medium for a so-called "hard disk" device. Accordingly, the characteristics necessary to the present invention are totally different from those of the magneto-optical recording media, and do not need the parameters disclosed in Table 1 on page 9 of EP '631.

In addition, JP '631 discloses that an amorphous alloy is necessary for a magneto-optical recording media. See the entire disclosure of JP '631, including the Title, Field of Invention Object of the Invention, and Summary of the Invention, which indicate that the invention of JP

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'631 is directed to an amorphous alloy. However, the present invention relates to a magnetic alloy having a crystallized structure, which is obvious to the person having ordinary skill in the art who reads paragraph [25] at page 7 of the present specification describing the order parameter, or the orientation of the crystal such as (001) or (002).

Accordingly, applicants submit that the reasons for the rejection are unfounded.

In particular, applicants submit that the Examiner's statement that Example 3 at page 9 of EP '631, which is an amorphous alloy, anticipates claim 1 of the present application is in error.

In view of the above, applicants submit that EP '631 does not anticipate claim 1 and, accordingly, request withdrawal of this rejection.

Claims 2 and 3 have been rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over EP '631.

The Examiner states that EP '631 is silent with respect to the properties recited in claims 2 and 3. The Examiner argues that the alloy disclosed in EP '631 would be expected to possess all of the same properties as recited in present claims 2 and 3 because the alloy disclosed in EP '631 has a composition that is encompassed by the present claims.

In response, and as discussed above, applicants submit that the alloy of Example 3 of EP '631 would not be expected to possess all of the same properties as recited in claims 2 and 3.

As stated above, the characteristics necessary to the magnetic alloy of the present invention are totally different from that of the magneto-optical recording media of the EP '631, and the magnetic alloy of the present invention do not need the parameters disclosed in the Table 1 on page 9 of EP '631.

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Therefore, although it may be possible to calculate the "S" value for the alloy of the Example 3 of EP '631, such value "S" will be zero, which has no technical meaning, because of the characteristics of the amorphous alloy. Moreover, it is impossible to calculate the Ku value as set forth in claim 3.

In view of the above, applicants submit that EP '631 does not disclose or suggest the subject matter of claims 2 and 3 and, accordingly, request withdrawal of this rejection.

Claims 4 and 5 have been rejected under 35 U.S.C. § 103(a) as obvious over EP '631.

The Examiner states that EP '631 teaches that the alloy of Example 3 can be used as a magnetic memory medium as disclosed at page 8, lines 46-49.

Applicants believe the Examiner intended to refer to page 6, lines 46-49 of EP '631, where it is disclosed that the amorphous alloy thin films have an easy axis of magnetization perpendicular to the film face and can be used in such various fields as magnetic recording materials, including vertical magnetic recording films, magnetic bubble memories and magneto-optical recording.

Claims 4 and 5 are dependent claims that depend ultimately from claim 1 or 2.

Accordingly, applicants submit that claims 4 and 5 are patentable for the same reasons as discussed above with respect to claims 1 and 2.

As stated above, the material itself of the present invention having a crystal structure is totally different from that of EP '631 having an amorphous structure.

In view of the above, applicants request withdrawal of this rejection.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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